

REMARKS

This response accompanies a Request for Continued Examination and a petition for a two-month extension of time. Claims 1-10 and new claims 16-19 are pending in the application. Claims 11-15 are withdrawn from consideration. Reconsideration of claims 1-10 is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 4,039,248 to *Franke et al.* in view of JP 63-265,209. Applicants respectfully traverse.

For patents to be applicable under 35 U.S.C. § 103(a), the combination of teachings must, *inter alia*, expressly or inherently, teach, disclose, or otherwise suggest each and every feature of the claimed invention. Additionally, motivation and suggestion to combine the patents must be present. In the present case, the Examiner has failed to establish a *prima facie* case of obviousness because the cited art, either alone or in combination, does not teach, disclose, or otherwise suggest each and every feature of independent claim 1. Specifically, claim 1 recites applying a filler composition in a foamed state discontinuously to the optical waveguide and forming a chamber element around the optical waveguide using an extruder....

As discussed in Applicants' response filed March 26, 2008, Figure 4 of *Franke* depicts foam bodies 6 introduced into the sheath 2 by means of holes 7 disposed at regular intervals in the sheath 2. Cols. 5-6, ll. 62-11 of *Franke*. Further, as noted in the previous response, *Franke* expressly states that foamed bodies 6 are introduced into the sheath 2 using holes at regular intervals to create an undulating configuration to protect from mechanical stresses and external forces. Col. 2, ll. 17-43.

In light of the *Franke's* teaching, one of ordinary skill in the art would not have been motivated to install foam bodies 6 in any manner other than at regular intervals through holes to create the desired undulating configuration since that modification might render the invention inoperable for its intended purpose. See *Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 52 USPQ 2d 1294, 1298 (Fed. Cir. 1999) (*quoting In re Spinnoble*, 160 USPQ 237, 244 (C.C.P.A. 1969)) If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination.

In the Final Office Action, the Examiner states that the present claims do not state when the sheath is extruded or how the foam bodies are placed therein. This assertion is irrelevant, however, in that it does not address why one of ordinary skill in the art would be motivated to modify *Franke's* device in contravention to *Franke's* expressed intent. Without motivation to modify *Franke* as required in the claims, there is no *prima facie* case for obviousness.

New claims 16-19 define over the cited art at least for the reasons already of record.

For at least these reasons, and the reasons stated in Applicants' March 26, 2008 response, withdrawal of the § 103(a) rejection of claims 1-10 is warranted and respectfully requested.

CONCLUSION


If any fees are due, please charge the fees, or credit any overpayment, to Deposit Account Number 03-3325.

Allowance of all pending claims is believed to be warranted and is respectfully requested.

The Examiner is welcomed to telephone the undersigned to discuss the merits of this patent application.

Respectfully submitted,

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